

REMARKS

1) **Summary of Prosecution to Date**

Notwithstanding the Applicant's Response to Office Action of January 24, 2005, the claims have again been rejected in the Office Action, made "Final" of April 6, 2005 for the same reasons as in the Office Action of September 22, 2004:

- (a) The requirement for restriction was made 'Final', and, in that regard of claims 1 – 49 pending in the case, claims 2, 9, 12 – 29, 36, 37, 39 – 41, and 43 – 49 were withdrawn from consideration.
- (b) All of the claims not withdrawn by the Examiner, namely claims 1, 3 – 8, 10, 11, 30 – 35, 38 and 42 were rejected. The rejections were:
 - (i) Anticipated under 35 USC 102 by US P 5,343,812 of Ishida – Claims 1, 3, 7 and 8;
 - (ii) Anticipated under 35 USC 102 by US P 3,399,631 of Weber – Claims 1, 3 – 5, 7, 8, 10, 11, 30 – 32, 38 and 42;
 - (iii) Obvious under 35 USC 103 given US P 3,399,631 of Weber in view of alleged common sense – Claims 33 – 35; and
 - (iv) Obvious under 35 USC 103 given US P 3,399,631 of Weber in view of US P 5,207,161 of Pilleggi – Claim 6.

2) **Rejections Based on Ishida (US P 5,343,812)—Claims 1,3,7 and 8**

Claims 1, 3, 7 and 8 were formerly rejected under 35 USC 102 in view of Ishida. In view of the amendments of claims 1 and 7, it is believed that the rejections formerly made on the basis of Ishida can no longer be made against these claims.

With regard to the Examiner's comments on enablement, the issue is not whether Ishida is enabling of Ishida's invention, but whether Ishida is enabling of the Applicant's claimed invention against which Ishida was cited as an anticipatory reference. The Applicant takes no position with regard to whether Ishida provides an enabling disclosure of Ishida's own invention.

3) **Cancellation of claims 4 and 10**

In view of the amendments of claims 1 and 7, claims 4 and 10 have been cancelled.

4) **Rejections based on Weber (US P 3,399,631) – Claims 1,3 – 5,7,8,10,11,30 – 32,38,42**

The Applicant thanks the Examiner for the telephone discussion of April 25, 2005. Although the Applicant does not agree that the Examiner's interpretation of the claims is that which would be understood by a person of ordinary skill in the art, with respect to claims 1 and 7 the Applicant acknowledges the Examiner's point with regard to the use of the words "comprising" and "consisting". In that light, the Applicant has re-written claims 1 and 7 to indicate that the rail road cars in question consist of an uneven number or railroad car units. The Applicant believes that this amendment overcomes the point raised by the Examiner.

With that amendment in mind, the applicant re-states the previously made argument made by written submission, and discussed by telephone with the Examiner. In the earlier rejection, the Office Action stated:

"Weber Figures 1 and 2, shows a multi-unit articulated railroad car as recited in the instant claims, including side-bearing arms 72, 73, 76, 77 articulated connectors 11 with male and female portions 18, 17 on trucks 9, 10 and the articulated connectors as shown in Figure 1, and the side-bearing arms as shown in Figure 2, are in symmetrical arrangements relative to the transverse centerline as claimed."

The Applicant respectfully disagreed, and continues to disagree. Weber Figure 1 is a schematic showing at least four units, 4, 5, 6, and 7, with articulated connectors between the four units. Weber Figure 1 does not show the connection between units 5 and 6, or between any units such as there may be between units 5 and 6. Therefore, Figure 1 cannot show that the articulated connectors of the railroad car shown are symmetrical about the transverse axis: it doesn't show them at all. However, Weber Figure 13 does show a connection between units 5 and 6, and between units 4 and 5. At the connection between units 6 and 5, (to the extent that the not overly detailed and rather schematic illustration can be said to show anything), it appears to indicate that the male portion of the connector is mounted to unit 6, and the female portion is mounted on unit 5. Similarly, the connection between unit 5 and unit 4 shows that the male portion of the connector is on unit 5 and the female portion is on unit 4.

Therefore, if the railroad car were to include only four units (being 4, 5, 6 and 7) then it could not satisfy the condition of having a symmetrical mounting arrangement of its connectors. (And also

would not have an un-even number of units). If the railroad car were to have more units, then the reader is no further ahead, since there is no information at all about those other units. It is a matter of trite law that a rejection under 35 USC 102 cannot be established on the basis of conjecture.

It may be noted that Figure 13 and its description are directed toward explanation of an alternate embodiment of side-bearing arms, not toward an alternate embodiment of connectors. There is nothing in Weber's description that would indicate either (a) that the arrangement of articulated connectors has been made symmetrical; or (b) that there is anything to be gained by making the arrangement symmetrical. Weber does not discuss the subject at all. That is, there is nothing in Weber that shows, describes or suggests the desirability of employing a symmetrical arrangement of articulated connectors.

Therefore, the Applicant respectfully submits that however a person skilled in the art may interpret the Weber reference, it does not show or describe a railroad car in a manner sufficient to support a rejection under 35 USC 102. The Applicant respectfully submits that Weber does not anticipate any of claims 1, 3, 5, 7, 8, 11, 30 – 32, 38, or 42.

5) **Rejections under 35 USC 103 Based on Weber (US P 3,399,631) – Claims 33 - 35**

In view of the foregoing commentary with respect to Weber, the Applicant respectfully submits that grounds for the rejection of dependent claims 33 – 35 have not been established.

In passing, the Applicant notes that the test for obviousness set forth in MPEP 2142 requires that the features alleged be present somewhere in the cited art. This would appear to be so whether those features are alleged to be a matter of common sense or not.

6) **Rejections under 35 USC 103 based on Weber in view of US P 5,207,161 of Pilleggi**

In view of the commentary made above with regard to Weber, the Applicant respectfully submits that *prima facie* grounds for rejection of claim 6 under 35 USC 103 have not been established. In addition, the Applicant respectfully submits that there is nothing in Pilleggi that shows, describes, or suggests a symmetrical arrangement of articulated connectors.

7) **Conclusion**

The Applicant respectfully submits that the claims as presently pending are in a condition for allowance. The Applicant therefore requests reconsideration of the current rejections and early and favorable disposition of this application.

Respectfully submitted,

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